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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/370,601	08/10/1999	KRISTINE B. FUIMAONO	34063/KMO/W1	8267

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EXAMINER

RODRIGUEZ, CRIS LOIREN

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 09/29/2003

29

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/370,601	FUIMAONO, KRISTINE B.
	Examiner Cris L. Rodriguez	Art Unit 3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 August 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2-16, 18-39, 41-49, 51, 52 and 54-59 is/are pending in the application.
- 4a) Of the above claim(s) 24-39 and 41-47 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2-16, 18-23, 48, 49, 51, 52 and 54-59 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |                                                                                                             |                                                                             |
|-------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>28</u> | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 2-4, 6, 7, 12, 14-16, 18, 48, 49, 51, 52, and 54-59<sup>60,61,62,63</sup> are rejected under 35 U.S.C. 102(e) as being anticipated by Desai (US 6,231,591).

Desai discloses an endoscopic surgical instrument assembly (figs. 25-36B) for tissue ablation having

- a probe body 309 with an ablation electrode 306 made of nickel-titanium or other resilient or conductive material (col. 18 lines 18-21) with at least one opening,
- means for introducing fluid into the inner cavity comprising an infusion tube 378 attached to the proximal end of the ablation electrode by means of adaptor 374 and sliding portion 338 (col. 19 lines 4-11),
- and a handle at 20. The probe body is generally rigid from its proximal to its distal end. The ablation electrode is generally straight and forms an angle with the remainder of the probe body.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-11, and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desai.

Desai discloses the invention substantially as claimed. However, Desai fails to disclose the tubular electrode being made of stainless steel, and the length and the diameters of the electrode and probe body as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select stainless steel for the electrode as an obvious design choice, since the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). Furthermore, the instant disclosure describes the length and diameters dimensions as being merely preferable, and does not describe it as contributing any unexpected result to the probe. As such, these parameters are deemed matters of design choice (lacking in any criticality), well within the skill of the ordinary artisan, obtained through routine experimentation in determining optimum results.

5. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desai in view of Ashley (6,176,857).

Desai discloses the invention substantially as claimed as discussed above. However, Desai fails to disclose the tubular electrode being malleable.

Ashley teaches a surgical instrument, (fig 4A-6A), where the tip and tubular shaft probe 404 (electrode) is made of the same tubing (such as a metal conducting shaft), .

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and the shaft can be a malleable stainless steel (col. 8 lines 40-59). Given the teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Ashley's malleable stainless steel material into Desai's needle electrode. Doing so would have improved the needle/electrode conformation, particular for the patient's body, to access the location to be treated.

***Response to Arguments***

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Thapliyal et al, Paddock et al, Gentelia et al, Haenggi, and Acosta et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cris L. Rodriguez whose telephone number is (703) 308-2194. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703) 308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

September 16, 2003

  
Cris L. Rodriguez  
Examiner  
Art Unit 3763

  
BRIAN L. CASLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700